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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/667,177	09/18/2003	Hartmut M. Hanauske-Abel	57768/41	8523

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EXAMINER

WANG, SHENGJUN

ART UNIT	PAPER NUMBER
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1617

DATE MAILED: 11/06/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/667,177

Applicant(s)

HANAUSKE-ABEL, HARTMUT M.

Examiner

Shengjun Wang

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-88 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claim(s) 1-88 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-14, drawn to a method of treating inflammation or allergic conditions in a living system comprising administering to the system a compounds defined by formula I and II, wherein the conditions are not those in invention groups II and III, classified in class 514, subclass 315, 451, 432, 690, 724.
 - II. Claims 1-7, 15-21, drawn to a method of treating cancer in a living system comprising administering to the system a compounds defined by formula I and II, classified in class 514, subclass 315, 451, 432, 690, 724.
 - III. Claims 1-7, 22-28, drawn to a method of treating obesity, diabetes mellitus, or metabolic syndrome in a living system comprising administering to the system a compounds defined by formula I and II, classified in class 514, subclass 315, 451, 432, 690, 724.
 - IV. Claims 1-7 drawn to a method of treating a living system comprising administering to the system a compounds defined by formula I and II, wherein the living system is other than those defined in invention groups I-III, classified in class 514, subclass 315, 451, 432, 690, 724.
 - V. Claims 29-38, drawn to a method of treating inflammation or allergic conditions in a living system comprising administering to the system a compounds defined

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by formula I and II, wherein the conditions are not those in invention groups VI and VII, classified in class 514, subclass 315, 451, 432, 690, 724.

- VI Claims 29-33, 39-43, drawn to a method of treating cancer in a living system comprising administering to the system a compounds defined by formula III and IV, classified in class 514, subclass 315, 451, 432, 690, 724.
- VII Claims 29-33, 44-48, drawn to a method of treating obesity, diabetes mellitus, or metabolic syndrome in a living system comprising administering to the system a compounds defined by formula III and IV, classified in class 514, subclass 315, 451, 432, 690, 724.
- VIII Claims 29-33 drawn to a method of treating a living system comprising administering to the system a compounds defined by formula III and IV, wherein the living system is other than those defined in invention groups V-VII, classified in class 514, subclass 315, 451, 432, 690, 724.
- IX Claims 49-58, drawn to a method of treating inflammation or allergic conditions in a living system comprising administering to the system a compounds defined by formula I and II, wherein the conditions are not those in invention groups X and XI, classified in class 514, subclass 315, 451, 432, 690, 724.
- X Claims 49-53, 59-63, drawn to a method of treating cancer in a living system comprising administering to the system a compounds defined by formula V and VI, classified in class 514, subclass 315, 451, 432, 690, 724.
- XI Claims 49-53, 64-68, drawn to a method of treating obesity, diabetes mellitus, or metabolic syndrome in a living system comprising administering to the system a

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compounds defined by formula V and VI, classified in class 514, subclass 315, 451, 432, 690, 724.

- XII Claims 49-53 drawn to a method of treating a living system comprising administering to the system a compounds defined by formula V and VI, wherein the living system is other than those defined in invention groups IX-XI, classified in class 514, subclass 315, 451, 432, 690, 724.
- XIII Claims 69-78, drawn to a method of treating inflammation or allergic conditions in a living system comprising administering to the system a compounds defined by formula I and II, wherein the conditions are not those in invention groups XIV and XV, classified in class 514, subclass 315, 451, 432, 690, 724.
- XIV Claims 69-73, 79-83, drawn to a method of treating cancer in a living system comprising administering to the system a compounds defined by formula VII and VIII, classified in class 514, subclass 315, 451, 432, 690, 724.
- XV Claims 69-73, 84-88, drawn to a method of treating obesity, diabetes mellitus, or metabolic syndrome in a living system comprising administering to the system a compounds defined by formula V and VI, classified in class 514, subclass 315, 451, 432, 690, 724.
- XVI Claims 69-73 drawn to a method of treating a living system comprising administering to the system a compounds defined by formula VI and VIII, wherein the living system is other than those defined in invention groups XIII-XV, classified in class 514, subclass 315, 451, 432, 690, 724.

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2. Inventions groups (I-IV), groups (V-VIII), groups (IX-XII) and groups (XIII-XVI) are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different designs, modes of operation, and effects (MPEP § 802.01 and § 806.06). In the instant case, the different inventions have different modes of operation. Particularly, compounds employed in the different groups are structurally distinct as the compounds characterized as monocyclic single ring, multiple rings, bicyclic ring, tricyclic ring. Search of these groups are not co-exist, and a reference render one group obvious under 35 U.S.C. 103, would not necessarily render the others obvious for the same reasons.
3. Inventions groups (I, V, IX, XIII), groups (II, VI, X, XIV), groups (III, VII, XI, XV) and groups (IV, VIII, XII, XVI) are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different designs, modes of operation, and effects (MPEP § 802.01 and § 806.06). In the instant case, the different inventions have different modes of operations. Particularly, the inventions are directed to therapeutical method for treating diseases with distinct etiologies and symptoms, and have acquired a separate status in the art of treating as a separate subject matter for inventive effect and require independent searches. It is noted that a reference to one treatment would not be a reference to another treatment under 35 U.S.C. 103. Therefore, restriction for examination purposes is proper.
4. Because these inventions are independent or distinct for the reasons given above and there would be a serious burden on the examiner if restriction is not required because the inventions have acquired a separate status in the art due to their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

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Each of the inventions of groups (I-XVI) are further restricted based on the characteristics of the Ring systems of the compounds.

A), wherein the compounds employed in the method do not have heteroatom in the ring systems, classified in class 514, subclass 690, 724.

B), wherein, nitrogen is in the ring system, classified in class 514, subclass 315.

C), wherein, sulfur, but no nitrogen, in the ring systems, classified in class 514, subclass 432;

D), wherein, oxygen, but not nitrogen or sulfur, in the ring system, classified in class 514, subclass 451.

The above inventions are unrelated and distinct each from the others because the compounds employed in the method are structurally distinct, as evidenced by the different class, subclass.

Further, search of all the compounds would be an undue burden as each class/subclass requires separated search.

5. Because these inventions are independent or distinct for the reasons given above and there would be a serious burden on the examiner if restriction is not required because the inventions have acquired a separate status in the art in view of their different classification, restriction for examination purposes as indicated is proper.

6. Claims 1-84 are generic to the following disclosed patentably distinct species: various compounds encompassed within the generic formula. The species are independent or distinct because of the various substituents presented in the general formula of the compounds. Applicant is required under 35 U.S.C. 121 to elect a single disclosed species, even though this requirement is traversed. Applicant is advised that a reply to this requirement must include an identification

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of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which depend from or otherwise require all the limitations of an allowable generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Applicant is advised that the reply to this requirement to be complete must include (i) an election of a species or invention to be examined even though the requirement be traversed (37 CFR 1.143) and (ii) identification of the claims encompassing the elected invention.

The election of an invention or species may be made with or without traverse. To reserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the restriction requirement, the election shall be treated as an election without traverse.

Should applicant traverse on the ground that the inventions or species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the inventions or species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C.103(a) of the other invention.

7. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the

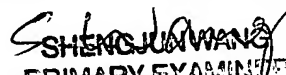
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application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shengjun Wang whose telephone number is (571) 272-0632. The examiner can normally be reached on Monday to Friday from 7:00 am to 3:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreeni Padmanabhan, can be reached on (571) 272-0629. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


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